



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/053,613 Confirmation No. : 4734
Applicant : TOSHIHIRO TAKAGI, et al.
Filed : January 24, 2002
TC/A.U. : 2614
Examiner : B. YENKE
Docket No. : 3064IT/50862
Customer No. : 23911
Title : CHANNEL SELECTION DEVICE USED IN
: DIGITAL/ANALOG BROADCASTING RECEIVER

REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated March 28, 2005, reconsideration and allowance of the above-identified application are respectfully requested. Claims 1-7 remain pending.

Initially, it is noted that, U.S. Patent No. 6,817,027 to Curreri ("Curreri") is cited in the response to arguments section for the disclosure of a channel list with multiple rows/columns where the user can use up/down or left/right controls to scroll through the channels. The purpose of citing Curreri is unclear, as it is not being relied upon to reject Applicants' claims. It should be noted that in the Reply filed November 3, 2004, Applicants' did not amend independent claim 2. Because the Office Action dated March 28, 2005 is a final Office Action, if Curreri is being relied upon to reject Applicants' claim 2, then this Office Action cannot be a final Office Action. Accordingly, because the Office Action dated March 28, 2005 is a final Office Action, and the reliance upon Curreri to reject Applicants' claim 2 would be a new grounds for rejection, which would prevent this Office Action from being made final, it is believed that Curreri is not being relied upon to reject Applicants' claims.

Therefore, Applicants' respectfully request that the next communication from the Patent Office clarify the purpose of the citation to Curreri.

Claims 1-7 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of the combination of alleged admitted prior art, U.S. Patent No. 6,084,643 to Kishtaka et al. ("Kishtaka") and U.S. Patent No. 6,249,320 to Schneidewend et al. ("Schneidewend"). This ground of rejection is respectfully traversed.

The rejection of Applicants' claims 1-7 is improper because it has not established a *prima facie* case of obviousness, the rejection is based upon an improper shifting of the burden of production to the Applicants' to prove non-obviousness, and it is based on reasoning contrary to the established law of obviousness under 35 U.S.C. § 103(a).

M.P.E.P. § 2143 sets forth the three basic criteria for establishing a *prima facie* case of obviousness. The first basic criteria is that there must be some suggestion or motivation to modify or combine the prior art. The third basic criteria is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." The Office Action has not established at least the first and third basic criteria for establishing a *prima facie* case of obviousness.

Regarding the third basic criteria, the rejection of Applicants' claim 1 is not entirely based upon prior art. As discussed in the Reply filed on November 3, 2004, the combination of alleged admitted prior art, Kishtaka, and Schneidewend does not disclose or suggest an input device that "has UP/DOWN keys and RIGHT/LEFT keys for giving a channel changing instruction, key pairs of which are assigned for main channel switch-over and sub-channel switch-over respectively" as recited in Applicants' claim 1.

In support of the rejection of claim 1, the Office Action concludes, without including a prior art reference in the rejection, that "if there were more channels per row, the left/right keys in addition to the up/down keys would also be used." In the absence of inclusion of a prior art reference in the rejection, the Office Action's conclusion of what could be performed if there were more channels per row is merely speculation. Because the rejection of claim 1 relies upon speculation as to what could be performed if certain modifications were made to the patents relied upon to reject Applicants' claim 1, the Office Action has not provided prior art references that disclose or suggest all of the elements of Applicants' claim 1.

Regarding the first basic criteria, the Office Action has not provided sufficient motivation for one of ordinary skill in the art to combine the patent in the manner relied upon to reject claim 1. In particular, to support the modification of the combination of the alleged admitted prior art, Kishtaka and Schneidewend to allow "the viewer the option of perusing the main or main/sub-channels via up/down and left/right keys" the Office Action asserts that one skilled in the art would have been motivated to "give[] the viewer the ability to quickly gauge any programs of interest." However, the Office Action has not explained why one skilled in the art would have ignored the express disclosure of the alleged admitted prior art and Schneidewend of listing main channels and sub-channels on the vertical axis, and instead allow a user to peruse "the main or main/sub-channels via up/down and left/right keys."

Because the Office Action has not provided prior art references, which when combined, disclose or suggest all of the elements of Applicants' claim 1, and because the Office Action has not provided motivation as to why one skilled in the art would

have ignored the express disclosure of alleged admitted prior art and Schneidewend of listing channels in a particular manner, the Office Action has not established a *prima facie* case of obviousness.

Additionally, the Office Action has improperly shifted the burden of production onto the Applicants to establish non-obviousness. As discussed in M.P.E.P. § 2142, the examiner bears the initial burden of factually establishing a *prima facie* conclusion of obviousness. "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

In response to Applicants' previous arguments, the Office Action concludes that "rearranging a layout of a menu which has assigned channels, and utilizing notoriously well known commands (up/down, right/left) within the menu, is not inventive, *since there are no unexpected results.*" (Office Action dated March 28, 2005 at page 3) (emphasis added). However, because the Office Action has not established a *prima facie* case of obviousness, there is no requirement for the Applicants' to produce proof of non-obviousness, such as the unexpected results being required by the Office Action. Because the Office Action is improperly shifting the burden of proof onto the Applicants without establishing the initial burden of production, the reasoning supporting the rejection of Applicants' claim 1 is contrary to the established law.

The rejection of Applicants' claim 1 is also improper because the reasoning supporting the rejection ignores elements recited in Applicants' claim 1. M.P.E.P. § 2141 states that when applying 35 U.S.C. 103, the claimed invention as a whole must be considered. M.P.E.P. § 2141.02, citing *W.L. Gore & Associates, Inc. v.*

Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), states that “[d]istilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole.’”

In the response to Applicants’ arguments, the Office Action states that “the alignment of channels either vertically or horizontally, is a matter of design choice and *thus bears no patentable weight*, where based upon the layout will prescribe the function keys to select/activate.” (Office Action dated March 28, 2005 at page 3) (emphasis added). Applicants’ claim 1 recites key pairs assigned to the input device which operate in a particular manner. It appears that the Office Action has concluded that the particular manner of operation in Applicants’ claim 1 bears no patentable weight. However, this conclusion is contrary to the law of obviousness under 35 U.S.C. § 103(a) that requires all elements of a claim to be considered.

Because the Office Action has not established a *prima facie* case of obviousness, is improperly shifting the burden to prove non-obviousness onto the Applicants and is ignoring elements recited in Applicants’ claim 1, the rejection of Applicants’ claim 1 is improper.

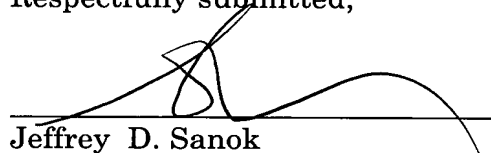
Applicants’ claims 2 and 6 recite similar elements to those discussed above with regard to Applicants’ claim 1. Claims 3-5 and 7 respectively depend from claims 2 and 6. Claims 2-7 are rejected on the same basis addressed above with regard to Applicants’ claim 1, and accordingly, the rejection of these claims is improper for similar reasons to those discussed above.

For at least those reasons stated above, it is respectfully requested that the rejection of claims 1-7 as allegedly being obvious in view of the combination of the alleged admitted prior art, Kishtaka and Schneidewend be withdrawn.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 010482.50862US).

Respectfully submitted,



Jeffrey D. Sanok
Registration No. 32,169
Stephen W. Palan
Registration No. 43,420

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CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
SWP:vlc
#382627v1